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10/726,719	12/03/2003	Keith A. Thuerk	BOC9-2003-0077 (448)	6364
40987 7590 04/01/2011 Novak Druce + Quigg LLP CityPlace Tower, 525 Okeechobee Blvd. Fifteenth-Floor WEST PALM BEACH, FL 33401				
EXAMINER				
FRITZ, BRADFORD F				
ART UNIT		PAPER NUMBER		
2442				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/726,719

Applicant(s)

THUERK, KEITH A.

Examiner

BRADFORD F. FRITZ

Art Unit

2442

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2010.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,38-42 and 45 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-5,38-42 and 45 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-945)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, filed 4/05/2010, with respect to the rejection(s) of claim(s) 1-5, 38-42, and 45 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Wick (6,691,162), Green et al. (2004/0172456), Aggarwal (6,260,148), Sylvain (2004/0122901), and Ogle et al. (6,430,604).

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, 38, and 45 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Regarding claims 1, 38, and 45, the phrase "types of inactive state" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-4, 38-41, and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable by Wick (6,691,162) in view of Green et al. (2004/0172456), hereinafter referred to as Green, in view of Aggarwal (6,260,148), further in view of Sylvain (2004/0122901).
7. Regarding claims 1, 38, and 45, Wick disclosed at least on memory (column 5, lines 6-55, column 6, lines 1-53, Fig. 2); and at least on processor (Fig. 2) configured to: displaying a user selectable list of subscribers in a graphical user interface of an instant messaging service (column 5, lines 6-55 and Fig. 5, Fig. 12); selecting at least one subscriber in an inactive state from the list of subscribers in the graphical user interface (column 5, lines 6-55, column 6, lines 1-53 and Fig. 5, Fig. 12), the inactive state being any state where an instant messaging session cannot be established with a subscriber (column 5, lines 6-55, column 6, lines 1-53 and Fig. 5, Fig. 12), types of inactive state including an offline state (column 5, lines 6-55, column 6, lines 1-53 and Fig. 5, Fig. 12); specifying a particular type of inactive state for each selected subscriber (column 5, lines 6-55, column 6, lines 1-53 and Fig. 5, Fig. 12); displaying in the graphical user interface options of action to be performed when the selected subscriber becomes active (column 5, lines 6-55, column 6, lines 1-53 and Fig. 12-13), wherein the options of action are configurable via the graphical user interface (column 5, lines 6-55, column 6, lines 1-53 and Fig. 12-13); designating at least one action from the options of action

for each specified type of inactive state via the graphical user interface (column 5, lines 6-55, column 6, lines 1-53 and Fig. 12-13), the at least one designated action to be automatically performed with respect to each subscriber when the subscriber's state changes from the specified type of inactive state to an active state (column 5, lines 6-55, column 6, lines 1-53 and Fig. 12-13); monitoring a state change for each selected subscriber (column 5, lines 6-55, column 6, lines 1-53 and Fig. 12-13); automatically detecting a state change of the selected subscriber (column 5, lines 6-55, column 6, lines 1-53 and Fig. 12-13); and automatically executing said designated action associated with said subscriber responsive to said detecting step (column 5, lines 6-55, column 6, lines 1-53 and Fig. 12-13).

However, Wick does not explicitly teach displaying in the graphical user interface the selected subscriber in a visually distinctive manner so as to identify the subscriber being monitored for a state change, wherein the visually distinctive manner includes at least one of a distinctive icon, a distinctive font, a distinctive font color, and a distinctive background color. Green teaches displaying in the graphical user interface the selected subscriber in a visually distinctive manner so as to identify the subscriber being monitored for a state change (paragraphs 0053, 0074-0075, 0082-0084, Fig. 6, *note the alert option and alarm bell icon next to Eric and also the icons to the right of the screen names items 606, 610*), wherein the visually distinctive manner includes at least one of a distinctive icon, a distinctive font, a distinctive font color, and a distinctive background color (paragraphs 0053, 0074-0075, 0082-0084, Fig. 6). It would have been obvious to one of ordinary skill in the art at the time of the invention to include the features as

taught by Green in the combination above because all are from the same field of endeavor and in order to visually distinguish buddies in the buddy list for whom the user has set events/options.

However, the combination above does not explicitly teach the types of inactive state including a do-not-disturb state. Aggarwal the types of inactive state including a do-not-disturb state (column 14, lines 10-30, 54-59 and column 15, lines 49-60). It would have been obvious to one of ordinary skill in the art at the time of the invention to include the features as taught by Aggarwal in the combination above because all are from the same field of endeavor and in order to subscribe to a buddy's status and be alerted whenever the status changes.

However, the combination above does not explicitly teach the types of inactive state including an out-of-office state. Sylvain teaches an inactive state including an out-of-office state (paragraphs 0030, 0072, and Fig. 7). It would have been obvious to one of ordinary skill in the art at the time of the invention to include the features as taught by Sylvain in the combination above because all are from the same field of endeavor and in order to subscribe to a status change when the status changes to "out-of-office" because "out-of-office" is an obvious type of inactive state because "[t]he number of properties and devices to which client A can subscribe is enormous. All that is necessary is that client A be able to send a subscribe message to the device, that the device measures or otherwise has notice of the value of the property desired, that client A properly addresses the object having the desired property, and that the device can send messages about the property to client A" (column 15, lines 50-60).

8. Regarding claims 2 and 39, Wick disclosed wherein said action is an instant messaging initiation action that initiates an instant messaging session between the user and said at least one subscriber (column 5, lines 6-55 and Fig. 5).

9. Regarding claims 3 and 40, Wick disclosed wherein said action includes at least one action selected from the group consisting of a notification action (column 5, lines 6-55 and Fig. 5), a prompting action (column 5, lines 6-55 and Fig. 5), and a message conveyance action (column 5, lines 6-55 and Fig. 5).

10. Regarding claims 4 and 41, Wick disclosed wherein all steps are performed by said instant messaging client (column 5, lines 6-55 and Fig. 5).

11. Claims 5 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wick (6,691,162) in view of Green et al. (2004/0172456), hereinafter referred to as Green, in view of Aggarwal (6,260,148), in view of Sylvain (2004/0122901), further in view of Ogle et al. (6,430,604), hereinafter referred to as Ogle.

12. Regarding claims 5 and 42, The combination disclosed the invention as described above. However, the combination does not explicitly teach wherein said instant messaging client includes a Lotus Sametime (TM) type client. Ogle teaches wherein said instant messaging client includes a Lotus Sametime (TM) type client (column 1, 20-33). It would have been obvious to one of ordinary skill in the art at the time of invention to include the Lotus Sametime IM client in the combination above because all are from the same field of endeavor of instant messaging and in order to use Wick's "pounce" with another IM client.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRADFORD F. FRITZ whose telephone number is (571)272-3860. The examiner can normally be reached on 8:00 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/B. F. F./
Examiner, Art Unit 2442

/KEVIN BATES/
Primary Examiner, Art Unit 2456